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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Crone et al.

Serial No.: **10/680,678**

Filed: **October 7, 2003**

For: **System and Method of Improving Customer Health, Reducing Income Tax by Charitable Gift, and Providing Hunger Relief for the Needy**

Patent Pending

Examiner: Mr. Florian M. Zeender

Group Art Unit: 3627

Confirmation No.: 5430

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April 27, 2006 — Date

Edward H. Green, III

SUPPLEMENTAL REPLY BRIEF

This Reply Brief is filed in response to the Supplemental Examiner's Answer, mailed March 27, 2006.

Grouping of Claims

Claims 1 and 11 do not stand or fall together. Claims 1 and 11 are argued separately in the Appeal Brief. Pursuant to 37 CFR § 41.37(c)(1)(vii), arguments related to each claim must be separately considered by the Board.

Reduced-portion Meal Product

Resolution of this appeal in Appellant's favor follows directly from the bedrock principle of patent law that an applicant may define claim terms in the specification. "As we have often stated, a patentee is free to be his own lexicographer. . . . The caveat is that any special

definition given to a word must be clearly defined in the specification." *Markman v. Westview Instruments, Inc.* 52 F.3d 967 (Fed. Cir. 1995) (in banc), *aff'd* 517 U.S. 370 (1996). When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989); MPEP § 2173.05(a).

The definition of a reduced-portion meal product cannot be more clearly stated than at p. 4, line 22 – p. 5, line 4 of the specification (emphasis added):

> Each reduced-portion meal product comprises the same elements as its corresponding full-portion meal product, but in reduced quantities. For example, a typical reduced-portion meal product may comprise a single hamburger in lieu of a double, a small order of fries in lieu of a large, and a small drink in lieu of a medium.

According to this definition, as a matter of existential mathematics, a meal without a beverage is not a reduced-portion version of a full-portion meal including the beverage. A hamburger without condiments is not a reduced-portion version of a full-portion meal comprising the hamburger including the condiments. That the Examiner can construct these entirely hypothetical meals is irrelevant to the patentability of either claim 1 or 11 – a *prima facie* case of obviousness must include prior art that teaches or suggests every claimed limitation. MPEP § 2143. The Examiner has failed to produce any prior art that teaches or suggests the claimed reduced-portion meal products, under the definition of that term that the Examiner is legally bound to follow.

Recognizing this fundamental and fatal flaw in his *prima facie* case of obviousness, the Examiner has chosen to ignore the clear and explicit definition, and attempt to obfuscate it by seizing on language in the specification that merely admits of variability within the confines of the definition: "Of course, those of skill in the art will readily recognize that a wide variety of reduced-portion meal product configurations, with concomitant cost and price structures, as well

as operating fees, are possible within the broad practice of the present invention." p. 5, lines 18-20.

However, the Examiner has provided no argument or reasoning to support his naked assertion that this statement would confuse one of ordinary skill in the art as to whether or not a particular meal configuration comprises a reduced-portion meal product under the controlling definition. It may indeed be one of a wide variety of possible configurations – from **A**sparagus to **Z**ucchini. However, for each and every such possible configuration, the test is precisely the same, it is crystal clear, and it is simple to apply: does the alleged reduced-portion meal product comprise the same elements as a corresponding full-portion meal product, but in reduced quantities? If so, it is a reduced-portion meal product within the controlling definition. If not – for example, if an element such as a beverage or condiments exists in a full-portion meal product but is entirely missing in an alleged reduced-portion meal product – then the latter is not a reduced-portion meal product within the controlling definition. All of the Examiner's hypothetical meal products fall outside the definition – they are simply inapposite to the claims.

The Examiner has failed to produce prior art teaching or suggesting the sale of a reduced-portion meal product at the price of a corresponding full-portion meal product, and transferring at least to some of the excess funds to a charity. Accordingly, the Examiner has failed to make out a *prima facie* case of obviousness with respect to either claim 1 or claim 11, and the § 103 rejections must be withdrawn. As each dependent claim includes all limitations of its parent claim(s), claims 2-10 and 12-20 likewise exhibit patentable nonobviousness over the art of record, and the § 103 rejections must be withdrawn.

Respectfully submitted,

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